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To: Art Unit 3729; **From:** Rhonda L. Sheldon
Technology Center Director

Company: USPTO **Date:** October 31, 2005

Fax: (571) 273-8300 **Pages:** 5

Your Re: Ser. No. 10/689,471 **Our Re:** MCT.0015C2US

Urgent **For Review** **Please Comment** **Please Reply** **Confirm Receipt**

AFTER FINAL—EXPEDITED PROCEDUREAttorney Docket No.: MCT.0015C2US
Date: October 31, 2005

RLS/njm

The Patent and Trademark Office date stamp sets forth the receipt date of the following documents in the below referenced patent application identified as follows:

Applicant(s): Tongbi Jiang
Serial No.: 10/689,471
Filing Date: October 20, 2003
Title: A Method for Forming a Stencil

1. Petition to the Technology Center Director

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

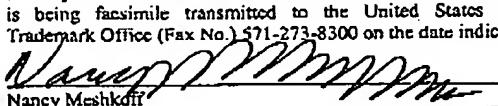
Applicant:	Tongbi Jiang	§ Group Art Unit:	3729
Serial No.:	10/689,471	§ Examiner:	Minh N. Trinh
Filed:	October 20, 2003	§ Confirmation No.:	4162
For:	A Method for Forming a Stencil	§ Atty. Dkt. No.:	MCT.0015C2US
		§ Customer No.:	21906

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Alexandria, VA 22313-1450

Petition to the Technology Center Director Under 37 C.F.R. § 1.181 and MPEP § 1002.02(c) 3(a), Premature of Final Rejection

The Office action mailed on August 31, 2005, was designated as a Final Office action. For the reasons expressed herein, the finality of this Office action is believed to be premature.

Date of Deposit: October 31, 2005
I certify that this document and authorization to charge deposit account
is being facsimile transmitted to the United States Patent and
Trademark Office (Fax No.) 571-273-8300 on the date indicated above.


Nancy Meshkoff

Facts Involved

1. On April 22, 2005, the examiner issued a first Office action (after a request for continued examination) rejecting independent claim 34 under 35 U.S.C. § 102(b) as being anticipated by Lee (US 5,872,399) and as being anticipated by Natarajan (US 5,519,580).
2. On June 22, 2005, applicant's representative responded to the Office action, amending the preamble of claim 34.
3. On August 31, 2005, a final Office action was issued rejecting claim 34 under 35 U.S.C. §103(a) as being unpatentable over Culp (US 4,490,217) in view of Suski (US 5,414,223) and/or Natarajan.
4. On September 19, 2005, applicant's representative responded to the Office action, amending claim 34 and requesting reconsideration of the finality of the rejection.

Points to be Reviewed

Should the Office action mailed on August 31, 2005 have been made final?

Requested Action

The decision maker is requested to grant this petition, withdraw the finality of the Office action dated August 31, 2005, and enter the claim amendments.

Legal Argument

The Office action mailed on August 31, 2005, should not have been made final. The policy of the United States Patent Office is that a clear issue should be developed prior to final rejection. MPEP §706.07. Moreover, an examiner should avoid switching from one set of references to another in rejecting in successive actions claims of substantially the same subject matter. *Id.* It is respectfully submitted that neither policy has been adhered to in at least the most recent final Office action.

For example, in a prior final Office action, claim 34 was rejected as being anticipated by Natajan. See Paper No. 20041102. In response thereto, claim 34 was amended to overcome a section 112 rejection and arguments were presented over

Natajaran. See Reply to Final Rejection, dated December 8, 2004. In a first Office action after a request for continued examination, the examiner reasserted that Natajaran anticipated claim 34 while also asserting that Lee anticipated claim 34. See Paper No. 20050404. The applicant's representative again presented arguments against the alleged anticipation by the Natajaran reference, presented arguments against the alleged anticipation by the Lee reference, and amended the preamble to claim 34. Nevertheless, the examiner entered a new ground of rejection on art not previously cited, making the next action final.

The basic thrust of the applicant's representative's arguments over Natajaran did not change from one response to the other. Namely, the solder mask 32 of Natajaran is a material that is put down to prevent the solder from flowing into adjacent solder landings and that it can be applied with conventional screening techniques; therefore, it is not a stencil. See Reply to Final Rejection, dated December 8, 2004 and Reply to Paper No. 20050404, dated June 22, 2005. A similar argument was made over the Lee reference. See Reply to Paper No. 20050404.

The subject matter of claim 34 is substantially the same before and after the amendment submitted on June 22, 2005, in that only the preamble was amended. Nevertheless, the examiner switched to a different set of references, making the action final. Moreover, a clear issue has not been developed before final rejection. Therefore, the examiner's actions are believed to be contrary to the policy of the United States Patent Office.

Additionally, an examiner should not introduce a new ground of rejection where it was not necessitated by the applicant's amendment of the claims. MPEP § 706.07(a). The amendment of the preamble of claim 34 was not believed to have changed the scope or nature of the examiner's search, thereby not necessitating a new ground of rejection. Thus, for this additional reason, the finality of the final Office action dated August 31, 2005 is believed to be premature.

Fee

A petition brought pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 20-1504 (MCT.0015C2US).

Statement that Petition is Timely Filed

The complained about action took place on August 31, 2005; thus, this matter has been addressed within two months of that date.

Respectfully submitted,



Date: October 31, 2005

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